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EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

54

Office Action Summary

Application No.

10/761,213

Applicant(s)

RONDEAU, CHRISTINE

Examiner

Margaret Einsmann

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 10/26/04
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-42 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Cotteret in view of Mockli.

Cotteret, U.S. Patent No. 5,735,908, teaches that the addition of a cationic or amphoteric substantive polymer to oxidation dye compositions which contain a p-phenylenediamine of formula (I) and preferably a coupler results in enhanced selectivity, increased intensity and uniformity, and improved fastness properties, see col. 1, line 50-col. 2, line 18.. Cotteret's preferred polymers include those as claimed, e.g. Polyquaternium-24, -37, -32 and -35, and Merquat 280, wherein the polymers are present in the claimed amounts, see col. 3, line 26-col. 4, line 60. Cotteret also teaches couplers as claimed as preferred for addition to such compositions, and that such compositions may contain direct dyes, see col. 5, lines 39-52. Cotteret also teaches that direct dyes may be added to the dyeing compositions, and that their dyes may be chosen from azo, nitro and anthraquinone dyes. See col 5 lines 53 et seq as well as col 6 lines 5 and 6. Cotteret fails to teach the addition of the specific direct dyes as claimed.

Mockli, WO 95/01772, teaches compositions for dyeing keratin fibers, particularly human hair, which comprise at least one cationic dye of formulae (1) to (6), which dyes overlap in scope with those as claimed, see Abstract and page 2, line 4-page 8, line 19. Mockli's preferred dyes include preferred dyes of formulae (I), (II), (III) and (III') as claimed, see Examples such as Examples 2-4, 11, 22, 46 and 65. Mockli teaches that the dyes may be mixed with assistants customarily used in cationic dye-containing hair

Art Unit: 1751

dye compositions, including cationic conditioning polymers (i.e. Polyquaternium 6), see page 11, lines 1-2 and Example 1. Mockli teaches that the patentee's dyes result in dyeings with improved color strength, and have improved light-, shampoo- and friction-fastness properties as compared to conventionally used cationic (direct) dyes such as Basic Blue 99, Basic Brown 16 and 17, Basic Red 76 and Basic Yellow 57, see page 1, lines 13-25 and Examples 1-6.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a composition for dyeing hair in the claimed forms which contain an oxidation base and cationic dye as claimed in the claimed amounts, a coupler in the claimed amounts, and a cationic or amphoteric polymer, oxidants, other direct dyes, and solvents as claimed, wherein the compositions may have pH's as claimed and may be forms as claimed, and wherein the compositions may be applied to hair in dyeing methods as claimed, because such compositions, methods fall within the scope of Cotteret's teachings. It would have been obvious to those skilled in the art to select a cationic dye as taught by Mockli as the direct dye in the composition of Cotteret because Mockli teach that said dyes are compatible with the cationic polymers, for example the polyquaternium polymers, that Cotteret uses, and Cotteret teaches that the claimed polymers result in various improved properties such as improved selectivity when used in oxidation dyeing compositions. Cotteret applies the dyes in the methods claimed, premixing with hydrogen peroxide before applying to the hair. See examples. It would have been obvious to one having skill in the art to provide the compositions in the kit as claimed in claim 40, since that is how oxidation hair dyes are ordinarily

Art Unit: 1751

provided to the consumer, in order to have a premeasured amount of dye and oxidant to mix directly before application.

Claims 1-23, 32-36 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kao Corp in view of Mockli.

Kao Corp, DE 29512302, teaches compositions for dyeing or toning human hair which comprise a direct dye and a hydroxyalkyl guar gum or a quaternary salt thereof. See English language abstract. The direct dyes include cationic dyes such as Basic Blue 99, Basic Brown 16 and 17, Basic Red 76 and Basic Yellow 57 (which read on the claimed additional direct dyes), and may be present in the claimed cationic dye amounts. See page 3 of the English translation for the dyes lines 20 and page 6 line 4. Kao Corp teaches that the compositions may also contain conditioning polymers in the claimed amounts, including specifically claimed polymers of dimethyldiallyl ammonium chloride and cationic vinylpyrrolidones. See page 4 of the translation fourth paragraph. The compositions are aqueous, may have the pH as claimed, and may be present in the claimed amounts. See English translation page 2 and page 5. Kao Corp exemplifies various compositions which contain basic direct dyes in combination with a cationic conditioning polymer which are applied to hair in dyeing methods as claimed. See the examples on page 5 of the translation. Kao does not teach cationic direct dyes of the claimed formulae.

Mockli, WO 95/01772, teaches compositions for dyeing keratin fibers, particularly human hair, which comprise at least one cationic dye of formulae (1) to (6),

Art Unit: 1751

which dyes overlap in scope with those as claimed, see Abstract and page 2, line 4- page 8, line 19. Mockli's preferred dyes include preferred dyes of formulae (I), (II), (III) and (III') as claimed, see Examples such as Examples 2-4, 11, 22, 46 and 65. Mockli teaches that the dyes may be mixed with assistants customarily used in cationic dye-containing hair dye compositions, including cationic conditioning polymers (i.e. Polyquaternium 6), see page 11, lines 1-2 and Example 1. Mockli teaches that the patentee's dyes result in dyeings with improved color strength, and have improved light-, shampoo- and friction-fastness properties as compared to conventionally used cationic (direct) dyes such as Basic Blue 99, Basic Brown 16 and 17, Basic Red 76 and Basic Yellow 57, see page 1, lines 13-25 and Examples 1-6.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate an aqueous composition in the claimed forms for dyeing hair which comprises a cationic dye in the claimed amounts and a cationic polymer as claimed in the claimed amounts, wherein the composition has a pH as claimed and is applied to hair in dyeing methods as claimed, because such dyeing compositions and methods fall within the scope of those taught by Kao Corp. Furthermore, Kao Corp's teaching that the claimed polymers are used to condition the hair would have motivated those skilled in the art to add such polymers to the patentee's compositions in order to get improved conditioning results. It would have been obvious to those skilled in the art at the time the invention was made to at least partially substitute the cationic dyes in Kao's compositions with a cationic dye as claimed because Mockli teaches that the claimed dyes result in improved color strength

Art Unit: 1751

and fastness properties as compared to the dyes used by Kao Corp. Mockli also teaches that the dyes may be mixed with customary hair dyeing additives, including cationic conditioning polymers, suggesting their compatibility in Kao Corp's compositions which contain substantive polymers as claimed.

These two rejections are maintained as applied in the non-final rejection. They are the same rejections which were affirmed by the board of appeals in the decision in the parent case 09/278,176 on 11/25/03. The arguments herein need not be considered since the board has already affirmed the prima facie obviousness of the rejections. The Declaration will now be considered.

The Declaration under 37 CFR 1.132 filed October 26, 2004 is insufficient to overcome the rejection of claims 1-42 based on Cotteret in view of Mockli and the rejection of claims 1-23, 32-36, 41 and 42 based upon Kao Corporation in view of Mockli as set forth in the last Office action for the following reasons.

In the declaration, Applicant compared three compositions:

1) One inventive composition comprising a single dye within the scope of the cationic dyes claimed combined with a quaternary ammonium polymer as claimed.

2) A composition comprising the same dye as in composition 1) combined with a cationic guar polymer. Composition A

3) A direct dye which is not cationic and not within the scope of the claimed dyes combined with the same quaternary ammonium polymer as claimed in composition 1.

Composition B

Art Unit: 1751

Applicant states that composition I is the inventive composition and composition A represents the Kao composition and composition B represents the Cotteret composition. The statement that composition A represents the Kao composition is not accurate because Kao was relied upon to teach the addition of cationic conditioning polymers to hair dyeing compositions containing basic (cationic) dyes. Kao Corp teaches that the compositions may also contain conditioning polymers in the claimed amounts, including specifically claimed polymers of dimethyldiallyl ammonium chloride and cationic vinylpyrrolidones. See page 4 of the translation fourth paragraph. Applicant did not compare a composition within the scope of Kao containing either dimethyldiallyl ammonium chloride or cationic vinylpyrrolidones polymers and a basic dye. Additionally, the cationic guar polymer falls within the scope of a cationic cellulose polymer as claimed. Kao suggests three of applicant's claimed polymers combined with basic dyes (cationic dyes).

Regarding the comparisons themselves, it appears that applicant has compared the inventive composition with a composition containing a direct dye which shows that that particular basic dye of the inventive composition 1 has different dye uptake properties from the dye which is not cationic. That comparison has no probative value because it is not commensurate in scope with the claims. Declarant states that the comparison shows that the lower value of delta E will produce a homogeneous color along the keratin fiber. That analysis is not understood. It appears that applicant is measuring the color coordinates before and after dyeing which measures the amount of dye uptake. It is unclear how that relates to a more homogeneous **color along the**

keratin fiber. Even if the comparison were convincing, it is not commensurate in scope with the claimed subject matter. A direct comparison with the compositions of the reference is required. Said comparison must be commensurate in scope with the claims. One exemplification of the claimed composition will not overcome the rejection.

Applicant is directed to M.P.E.P716.02 (d) and (e) for the requirements of comparisons which will overcome a prima facie case of obviousness. Objective evidence of unobvious results must be commensurate in scope with the claims. *In re Prater*, 162 USPQ 541; *In re Tiffin*, 172 USPQ 292; *In re Linder*, 172 USPQ 356; *In re Greenfield*, 197 USPQ 227

Where unobvious results are relied upon as a basis for patentability, a proper comparative showing is a minimum requirement. *In re Eisenhut*, 114 USPQ 287

Double Patenting

The terminal disclaimer has been entered and has mooted the double patenting rejection over US 6,592,633.

The rejections under the second paragraph of 35 USC 112 have been mooted by applicant's amendments.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 571-272-1314. The examiner can normally be reached on 7:00 AM -4:30 PM M-Th and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/761,213

Page 10

Art Unit: 1751

Margaret Einsmann

Margaret Einsmann

Primary Examiner

Art Unit 1751

12/13/04